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APPEAL BRIEF

Atty. Docket No. 25720-702

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application)	
)	Confirmation No.: 5843
Inventor: Mark Killmer)	
)	Art Unit: 2152
Application No.: 09/921,003)	
)	Examiner: Angela M. Widhalm
Filed: August 01, 2001)	
)	
Title: Online Network and Associated Methods)	Customer No. 021971

APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits this brief in accordance with the provisions of 37 C.F.R. § 41.37 in response to the Final Rejection mailed April 18, 2006. Appellant's Notice of Appeal was filed on October 16, 2006.

Unless a check is submitted herewith for the fee required under 37 C.F.R. 41.20(b)(2), please charge said fee to Deposit account No. 23-2415.

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I. REAL PARTY IN INTEREST

The real party in interest is LTD Networks Pty, Ltd. (Assignee) by virtue of an assignment executed by the inventor (Appellant) to LTD Network Party Ltd. (recorded by the Assignment Branch of the U.S. Patent and Trademark Office on November 1, 2001 at Reel/Frame 012357/0961).

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

In the application under appeal, claims 1-14 are pending. Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Guheen et al. US Patent No. 6,721,713 (hereinafter "Guheen"). The rejections of claims 1-14 are appealed. Claims 15-33 have been withdrawn.

IV. STATUS OF AMENDMENTS

Appellant has submitted no amendments after the final rejection. All amendments prior to the close of prosecution on the merits have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

One embodiment comprises a computer program capable of monitoring the activity of a user including monitoring and identifying particular online sites viewed by the user and the category and subject matter related thereto. Claim 1 includes, for example, a means for cross-referencing any determined subject matter categories with a second index of alternative online sites categorized by subject matter, in order to determine any alternative online sites in the same or similar category. A program may, in an example embodiment, identify a particular category of web site the user is visiting and display a list of alternative online sites of the same or similar category to the user for which the user may visit (see specification at page 5, lines 8-12). In a further embodiment, such display of alternative online sites may comprise, for example, a display of hyperlinks to allow the user to navigate easily to such alternative online sites (see

specification at page 5, line 21). The program may achieve the preceding, for example, by use of certain rules of thumb and the ability to reference a database containing an index of URLs and key words. In yet a further embodiment, the database may, for example, be embedded in the program itself or, in another embodiment it may, for example, reside on a remote server (see specification at page 5, lines 13-19).

Another embodiment is directed to a method of comparative advertising. Such method may, in an example embodiment, include the steps of analyzing an online site viewed by a user to identify subject matter and displaying to the user information relating to alternative online sites with the same or similar subject matter (see specification at page 3, lines 29-32). A method of comparative advertising in an online environment is claimed in exemplary claim 5.

A method of comparative advertising in an online environment is claimed in claim 10. A method of comparative advertising may, for example, include the steps of analyzing an online site viewed by a user to identify products advertised on the site and displaying to the user information relating to competing products on alternative online sites (see specification at page 4, lines 1-4). A further embodiment may include, for example, recognizing a competing product by analyzing the current web page to find references to particular product(s). For example, the analysis may be cross referenced to a database with appropriate terms to identify the "competing products" in order to determine whether a "competing product" is on offer, according to an embodiment (see specification at page 6, lines 13-16). For example, according to an embodiment, a multitude of web sites may be searched to find such competing products. Further embodiments may include, for example, determining that a competing product is on offer, then displaying to the user, in one embodiment, in a separate window or, in another embodiment on the user's computer monitor, information regarding the competing product (see specification at page 6, lines 14-19).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests the Board of Patent Appeals and Interferences review the following ground of rejection on appeal:

1. Whether claims 1-14 are patentable under 35 U.S.C. § 102(e) over Guheen.

VII. ARGUMENT

Appellant respectfully submits that claims 1-14 are in proper form and are patentable over the prior art of record.

Claims 1-14 Are Patentable over Guheen

Independent claims 1, 5 and 10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Guheen. Appellant respectfully disagrees.

Section 102(e) reads, in relevant part, that "A person shall be entitled to a patent unless –
(e) the invention was described in (2) a patent granted on an application for patent by another filed in the United States before the invention by the Appellant for patent ..."

Section 102 requires that, for a reference to anticipate, it must disclose each and every element of the claimed invention. Therefore, in particular, for section 102(e) to apply herein, Guheen must disclose each and every element of the instant claimed invention. Appellant respectfully contends that Guheen does not disclose each and every element of the instant claimed invention and therefore does not qualify as 102(e) prior art in the instant case. Appellant asserts that Guheen fails to do so for the following reasons:

With respect to independent claim 1, the Examiner contends that claim 1 is anticipated by Guheen. Specifically, the Examiner contends that Guheen discloses "a computer program product including means for comparing (comparing products/services) a URL, title and/or content of an online site viewed by a user with a first index of keywords relating to a plurality of subject matter categories, to determine any subject matter categories to which the online site relates; means for cross-referencing any determined subject matter categories with a second index of alternative online sites categorized by subject matter, in order to determine any alternative online site in the same or similar category; and means for displaying any determined alternative online sites to the user." The Examiner cites to Guheen col. 170, lines 30-66; col. 178, lines 20-36; and col. 187, lines 1-65 to support the contention that claim 1 of the instant

application is anticipated by Guheen (USPTO Office Action dated 04/18/2006 ("Office Action"), p. 2). Appellant respectfully disagrees.

Nowhere in the cited passages does Guheen teach a computer program as claimed in claim 1 including, for example, "a means for cross-referencing any determined subject matter, with a second index of alternative online sites categorized by subject matter, in order to determine any alternative online sites in the same or similar category; and a means for displaying any determined alternative online sites to the user." Rather, Guheen, in column 170, lines 30-66, and the cited Fig. 66, simply disclose a virtual shopping cart where information from numerous products and vendors is obtained and derived from within a particular online site. Nowhere in the cited passage, however, does Guheen disclose a "means for cross-referencing ... with a second index of alternative online sites ... in order to determine any alternative online sites to the user." Rather, Guheen discloses an online site where a variety of products can be accessed presumably from the same online site and not from an alternative online site. As stated above, Guheen does not teach the use of alternative online sites as claimed in claim 1. Columns 178 and 187 of Guheen also fail to teach the invention claimed in claim 1. Column 178, lines 20-36, simply describes the use of keywords. Column 187, lines 1-65, simply describes advertising. Therefore, because of the failure of Guheen to teach all of the elements of claim 1 of the instant application, the reference does not anticipate the instant claimed invention.

Examiner asserts that Guheen teaches that "the data relating to at least one of the products and services may include a link to related data, and the comparison between different products and services could include a comparison to a competitor's product." (Office Action at 4 citing to Guheen col. 170, lines 56-61). The Examiner also asserts that Guheen teaches "that links to web pages may be selected to access related sites. (Office Action at 4 citing to Guheen col. 205, lines 65-66).

However, these cited portions of Guheen still fail to teach the claimed means for cross-referencing any determined subject matter categories with a second index of alternative online sites as claimed in claim 1.

The cited portions of Guheen are in connection with an aspect of Guheen completely different from what is claimed in claim 1. In particular Guheen states

An interface could be provided that permits discussions across multiple discussion groups. Optionally, links to web pages may be selected to access related sites and published documents. Also, search capabilities could be provided to search for information. Notification tools may inform a user of various events, such as when a particular discussion is going to occur.

(Office Action at 4 citing to Guheen col. 205, lines 65-66). Thus, the preceding cited portion of Guheen relates to an interface for discussions across discussion groups. In contrast, claim 1 relates to cross-referencing any determined subject matter categories with a second index of alternative online sites as claimed in claim 1, in particular subject matter categories to which a URL, title and/or content of an online site viewed by a user has been related, with a first index of keywords relating to a plurality of subject matter categories, to determine any subject matter categories to which the online site relates.

The Examiner asserts that Guheen's discussion of related sites would teach links to other related products / pages that may be located on other online sites. However, even assuming such a conclusion is correct, Guheen still fails to teach the claimed means for cross-referencing any determined subject matter categories, including means for comparing a URL, title and/or content of an online site viewed by a user with a first index of keywords relating to a plurality of subject matter categories, to determine any subject matter categories to which the online site relates.

Rather, the Examiner is attempting to piece together unrelated portions of the reference Guheen in order to build the Appellant's invention. Appellant points to MPEP 2131 (regarding Anticipation -- Application of 35 USC 102(a), (b), and (e), subsection entitled "To Anticipate a Claim, the Reference Must Teach Every Element of the Claim"), which states

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.
(emphasis added).

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Additionally, it is noted that MPEP 2131 requires "The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test...". (MPEP 2131 citing to *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In this regard, the Examiner has failed to find a teaching in Guheen of for cross-referencing any determined subject matter categories, including means for comparing a URL, title and/or content of an online site viewed by a user with a first index of keywords relating to a plurality of subject matter categories, to determine any subject matter categories to which the online site relates. The Examiner seems to be pointing to disjointed aspects of Guheen that fail to teach the claimed arrangement of elements.

Appellant contends that Guheen does not anticipate independent claims 5 and 10 of the instant application for the same reasons articulated for claim 1, supra. As in claim 1, an alternative online site is referred to in claims 5 and 10. The Examiner cites to col. 170, lines 56-65, of Guheen to support the contention that claims 5 and 10 are anticipated by Guheen. These lines simply disclose that the featured "displayed catalog may be customized based upon the user profile ... [and] the data relating to at least one of the products and services may include a link to related data ... [and] the comparison between different products and services could include identification of at least one advantage of the at least one of products and services ... [and] the recommendation of at least one of the products and services includes a financial analysis of at least one of the products and services." Nowhere in the cited passage of Guheen is found disclosure about alternative online sites. In the cited passage, Guheen simply discloses a single online site that displays to the user a variety of products and vendors, which may be achieved by accessing the information from within its own online site. This is very different from the teachings of the instant application, which disclose a means of querying and displaying information from an alternative online site. Therefore, because Guheen does not disclose a means for "displaying to the user information relating to alternative sites," as claimed in claim 5, or "displaying to the user information relating to competing products on alternative online sites," as claimed in claim 10, claims 5 and 10 of the instant application are not anticipated by Guheen.

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Because all other pending claims of the instant application depend from either independent claims 1, 5, or 10, Appellant has not addressed the Examiner's arguments that the dependent claims would be anticipated by Guheen. Since Appellant contends that Guheen does not teach a means to determine alternative online sites or means for displaying any determined alternative online site to the user (as claimed in claim 1) or displaying to the user information relating to alternative online sites (as claimed in claims 5 and 10), claims 1, 5, and 10, are not anticipated by Guheen. Therefore, a priori, all dependent claims flowing from claims 1, 5, and 10 are not anticipated by Guheen.

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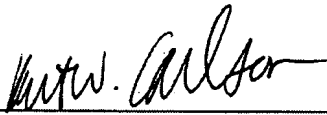
CONCLUSION

For the reasons stated above, claims 1-14 are patentable over the prior art of record, and the rejections of those claims under 35 U.S.C. § 102(e) are improper and should be withdrawn. Appellant respectfully asks the Board to reverse the Examiner's rejections with instructions to allow the claims.

The USPTO is directed and authorized to charge all required fees to Deposit Account No. 23-24215 (25720-702).

Respectfully submitted,

Date: October 19, 2007



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VIII. CLAIMS APPENDIX

1. A computer program product including:

means for comparing a URL, title and/or content of an online site viewed by a user with a first index of keywords relating to a plurality of subject matter categories, to determine any subject matter categories to which the online site relates;

means for cross-referencing any determined subject matter categories with a second index of alternative online sites categorised by subject matter, in order to determine any alternative online sites in the same or similar category; and

means for displaying any determined alternative online sites to the user.

2. The computer program product of claim 1 wherein the first and second indexes are contained in a database remote from the computer program product.

3. The computer program product of claim 1 further including:

means for determining a geographic locality relating to the user; and

means for determining any alternative sites in the same or a proximate geographical locality to that relating to the user, so that the displaying means displays any of the determined alternative sites in the same or a similar subject matter category, that are also in the same or a proximate geographical locality.

4. The computer program product of claim 2 further including:

means for determining a geographic locality relating to the user; and

means for determining any alternative sites in the same or a proximate geographical locality to that relating to the user, so that the displaying means displays any of the determined

alternative sites in the same or a similar subject matter category, that are also in the same or a proximate geographical locality.

5. A method of comparative advertising in an online environment including the steps of:

analysing an online site viewed by a user to identify subject matter;
displaying to the user information relating to alternative online sites with the same or similar subject matter.

6. The method of claim 5 further including the step of determining a geographical locality relating to the user and only displaying alternative sites in the same or a proximate geographical locality.

7. The method of claim 6 wherein the geographical locality relating to the user is determined by analysing the user's electronic address and/or the address of the online site viewed by the user.

8. The method of claim 5 wherein the analysis step is performed by analyzing the URL, title and/or content of the online site.

9. The method of claim 5 wherein the information displayed to the user includes hyperlinks to the alternative online site(s).

10. A method of comparative advertising in an online environment including the steps of:

analysing an online site viewed by a user to identify products advertised on the site;

displaying to the user information relating to competing products on alternative online sites.

11. The method of claim 10 wherein the analysis step is performed by analyzing the URL, title and/or content of the online site.

12. The method of claim 9 wherein the information displayed to the user includes hyperlinks to the alternative online site(s).

13. The method of claim 10 wherein the displayed information includes a price of the competing product(s).

14. The method of claim 13 further including the steps of:
determining whether the competing product price is less than the price of the identified product on the online site viewed by the user; and

- (i) if less, displaying the competing product price to the user; or
- (ii) if not less, ascertaining a best price relating to the competing product and displaying the best price to the user or a value in-between.

IX. EVIDENCE APPENDIX

U.S. Patent No. 6,721,713 (Guheen) cited by Examiner in office action mailed on 08/03/2005 and in office action mailed on 04/18/2006.

X. RELATED PROCEEDINGS APPENDIX

None.